



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,755	09/17/2001	Henri Jacques Suermondt	10007909	8507
7590 12/07/2004			EXAMINER	
HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400			HIRL, JOSEPH P	
			ART UNIT	PAPER NUMBER
			2121	

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/954,755

Applicant(s)

SUERMONDT ET AL.

Examiner

Joseph P. Hirl

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This Office Action is in response to an AMENDMENT entered August 30, 2004 for the patent application 09/954,755 filed on September 17, 2001.
2. All prior office actions are fully incorporated into this office action by reference.

### ***Status of Claims***

3. Claims 1-16 are cancelled. Claims 17-30 are new. Claims 17-30 are pending.

### ***Claim Objections***

4. Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. "Degree of correctness" is synonymous with "accuracy of the classifier" and without any specificity as to the methodology of calculation, claim 18 does not further limit the independent claim 17.
5. Claim 23 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Art Unit: 2121

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

“Assigning an indifferent indication to each category in the hierarchy that does not contribute to a measure of accuracy of the classifier” has no affect or limitation on claim 17’s accuracy of the classifier.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. “Tendency” is a relative term and renders the claim indefinite.

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 17-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Art Unit: 2121

**Claim 17**

The specification is silent on assigning and evaluating “first”, “second”, “third” and “fourth” indications.

**Claim 18**

The accuracy provides an indication of a degree of correctness rendered by the classifier where correctness is provided by the authoritative classifier ... not in classifying the item.

**Claim 19**

The specification @ p 11, l 6-15 does not address “in the hierarchy.”

**Claim 20**

See claim 17 comments. The specification is silent on “numerical range.”

**Claim 21**

See claim 17 comments. The specification is silent on use of the term “the first indication to all ancestors of a category.”

**Claim 22**

See claim 17 comments.

**Claim 23**

See claim 17 comments.

**Claim 24**

See claim 17 comments.

Art Unit: 2121

**Claim 25**

The specification is silent on the averaging of first and second tendencies. However, the specification @ p 10, l 7-9 does average over-conservativeness and over-aggressiveness.

**Claim 26**

The specification is silent on combining first and second tendencies with a harmonic mean to obtain the accuracy of the classifier. However, the specification @ p 10, l 9-13 does create a harmonic mean using over-conservativeness and over-aggressiveness.

**Claims 27, 28, 29**

See claim 17 comments.

**Claim 30**

See claim 17 comments. Question 1: How does the term "indication" of claims 17-29 relate to claim 30? Question 2: Is there one or two "items" being classified? In the first two steps, it appears that there is one item being classified. However, in the next two steps, each step refers to "the item" of a specific category which would mean that there are two items...? But then, there appears to be but one item in the last step ...?

***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Art Unit: 2121

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 17-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Claims 17-30 are not embodied in the technological arts. Simply stated and in a trivial but applicable application, the invention can be implemented with pencil and paper. This rejection can be overcome by inserting the term "computer implemented" prior to "method" in the preamble of independent claims 17, 27 and 30.

### ***Response to Arguments***

12. The objection to the specification is withdrawn.

13. With the canceling of claims 1-16, the original rejection of claims 1-16 under 35 USC 112, second paragraph, is withdrawn. However, new claims 17-30 are rejected under 35 USC 112, first and second paragraph, as noted above.

14. With the canceling of claims 1-16, the original rejection of claims 1-16 under 35 USC 101 is withdrawn. However, new claims 17-30 are rejected under 35 USC 101 as noted above.

Art Unit: 2121

15. With the canceling of claim1, the original rejection under 35 USC 102 (b) is withdrawn. However, depending on how claims 17-30 are amended to meet the requirements of 35 USC 101 and 112, the prior art of Peele et al and/or others may still apply.

### ***Examination Considerations***

16. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

17. Examiner's Notes are provided to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and unless otherwise stated, the Examiner's Notes are



Art Unit: 2121

not prior art but a link to prior art that one of ordinary skill in the art would find inherently appropriate.

18. Examiner's Opinion: Paras 16. and 17. apply. The Examiner has full latitude to interpret each claim in the broadest reasonable sense. The claims and only the claims form the metes and bounds of the invention. While the substance of the specification may qualify for an allowance, the claims must somehow bring forth such substance ... use the terminology of the specification in the claims.

### ***Conclusion***

19. Claims 17-30 are rejected.

### ***Correspondence Information***

Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (571) 272-3685. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Knight can be reached at (571) 272-3687.

Any response to this office action should be mailed to:

Art Unit: 2121

Commissioner of Patents and Trademarks,

Washington, D. C. 20231;

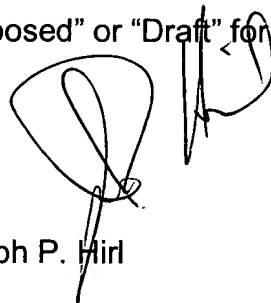
or faxed to:

(703) 872-9306 (for formal communications intended for entry);

or faxed to:

(571) 273-3685 (for informal or draft communications with notation of

"Proposed" or "Draft" for the desk of the Examiner).

A handwritten signature in black ink, appearing to read 'J. P. Hirl', with a large, stylized loop at the end.

Joseph P. Hirl

December 1, 2004